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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,333	08/29/2001	Christopher M. Angelucci	8932-546	7696

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 11/21/2003 8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/942,333

Applicant(s)

ANGELUCCI ET AL.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) 27-53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2-4.6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of Group I, i.e. claims 1-44, and Species III, i.e. Figures 5A-5C, in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Species I, IV, and V are implants used for the same purposes as the Species III and that dividing between these figures is improper and applicant refers to MPEP 808.02. This is not found persuasive. It is noted that because all the different embodiments of Species are for the same purposes, does not mean that they are different from each other and that is why an election requirement has been made over the different embodiment of the implants. Moreover, with regard the argument about that dividing between figures is improper, it is noted that "species are always the specifically different embodiments" (see MPEP 806.04(e)). With regard applicant's argument about referring to MPEP 808.02, it is noted that 808.02 is related to related inventions which are shown to be distinct under the criteria of MPEP 806.05(c)-806.05(i). It is noted that for an election requirement it is not necessary to show a separate status in the art or separate classification (see MPEP 808.01(a)). Moreover, 806.04(e) states that "Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other." and applicants have not traverse the election requirement on the ground that the species are not patentably distinct, thus confirming the examiner's position. Also, applicants have not submitted evidence or identified such evidence now of record showing the Species to be OBVIOUS variants or clearly admitting on the record that this is the case.

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It is acknowledged that applicants believe claims 1-26 read on the elected Species I, i.e. Figures 5A-5C, and that claim 1 is a generic claim. The examiner agrees that claims 1-26 read on the elected Species, however, claim 1 is not a generic claim. A generic claim is one that read on **all** the different Species, e.g. all Species I-VIII (see MPEP 806.04(d)).

Claims 27-53 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-17, 20, and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2, "the spinal column" lacks a prior antecedent.

In claim 2, line 1, "the intersection" lacks a prior antecedent.

In claim 14, line 2, "the intermedullary canal of the donor bone" lacks a prior antecedent.

In claim 20, line 2, "the intermedullary canal of the donor bone" lacks a prior antecedent.

In claim 25, line 1, "the inner side region" lacks a prior antecedent.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 8-11, 16, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Cottle (Reference US Patent “5,888,227” cited in IDS).

Cottle discloses an implant comprising a body portion having a length and configure to be insertable between first and second bone ends (see for example Figures 4-8). The body portion has an outer surface and an inner surface which defines a hollow portion. The body portion also has an inner side region having an inner side length and first and second ends, 11 and 12, which communicates with the hollow portion. The first and second ends 11 and 12 include bone engaging portions having surface projections 18. The bone engaging portions are angled with respect to each other (see Figures 6 and 7). An intersection between the inner side region and the bone engaging portions comprises an angle (see Figures 6 and 7). The outer surface of the implant has a geometric shape, e.g. rectangle (see Figure 7). The projections as saw tooth ridges or pyramidal teeth. Each first and second ends include channel which are capable of accept arms of a distractor (see Figure 4). The body further comprises a plurality of holes or apertures which are capable of receiving suture. The implant can be made from metal or polymer (see col. 48-50).

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Claims 1, 2, 4, 5, 7-9, and 12-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Boyle et al. (Reference US Patent "6,277,149" cited in IDS).

Boyle et al. disclose an implant comprising a body portion having a length and configure to be insertable between first and second bone ends (see for example Figures 1-4 and 10-19). The body portion has an outer surface and an inner surface which defines a hollow portion. The body portion also has an inner side region having an inner side length and first and second ends, e.g. 22 and 24, which communicates with the hollow portion. The first and second ends include bone engaging portions having surface projections, e.g. 28. The bone engaging portions are angled with respect to each other (see Figures 1, 3, 9, 10-6, and 18). An intersection between the inner side region and the bone engaging portions comprises an angle. The outer surface of the implant has a geometric shape, e.g. circle, rectangle, oval, etc. (see all Figures). The projections as can be pyramidal teeth shape (see col. 4, lines 26-28). The implant can be made from metal, polymer, bone, or demineralized bone (see col. 4, lines 29-41 and col. 5, lines 17-19).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle et al. (Reference US Patent "6,277,149" cited in IDS).

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Boyle et al. disclose the claimed invention except for the angle ranging from about 50 to about 70 degrees, the inner side length ranging from about 6 to about 10 mm, the width ranging from about 10.0 to about 11.5 mm and the depth ranging from about 6.5 to about 7.5 or 7.7 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the implant of Boyle et al. with the angle ranging from about 50 to about 70 degrees, the inner side length ranging from about 6 to about 10 mm, the width ranging from about 10.0 to about 11.5 mm and the depth ranging from about 6.5 to about 7.5 or 7.7 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

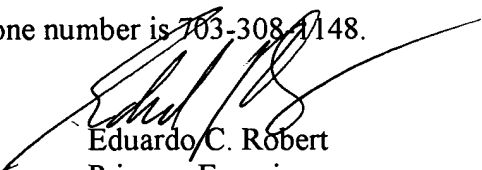
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.